

REMARKS

The Office Action dated September 18, 2003 has been carefully reviewed. Claims 1-20 are pending in this patent application. Reconsideration of this application is respectfully requested.

Double Patenting Rejection of Claims 1-20

Claims 1-20 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-17 of U.S. Patent No. 6,355,045.

A Terminal disclaimer is submitted herewith in order to obviate the above rejection.

Amendment to Specification

The specification has been amended to update data concerning a related patent application.

35 U.S.C. § 103 Rejection

Claims 1-20 were rejected under 35 U.S.C. § 103 as being unpatentable over Wildgoose et al. (U.S. Patent No. 5,690,636) in view of Steele et al. (U.S. Patent No. 5,312,411).

Discussion Regarding Patentability of Claim 1

Claim 1

Claim 1 reads as follows:

1. A surgical assembly for preparing a tibia for implantation of a prosthetic implant, comprising:
 - a tray trial adapted to be secured to a proximal end of the tibia and defining a plate opening therethrough, said plate opening having a center point; and
 - a first guide adapted to be secured to said tray trial, wherein said first guide defines at least a first bore and a second bore therethrough, each of said first and said second bores having a center point arranged to be offset from said center point of said plate opening of said tray trial when said first guide is secured to said tray trial.

The invention defined in claim 1 addresses a particular problem in the medical arts. Specifically, a condition which renders surgical preparation relatively difficult is the case in which the tibial canal of the patient's tibia is offset from, or otherwise not coincident with, the center of the tibia. Indeed, it is known that the anatomy of some patients may create a situation in which the tibial canal of the patient's tibia is offset from the center of the tibia by as much as three to four millimeters (3-4 mm). Such an offset is above and beyond a slight anterior-posterior offset of the tibial canal which is inherent in most patient's anatomies. It should be appreciated that if a tibial implant having a stem which is centered relative to the implant's plate is implanted into a patient's tibia which has an offset tibial canal, undesirable impingement of the stem into contact with the cortical bone of the tibia may result.

Applicants' invention of claim 1 is directed at overcoming, and in fact does overcome, the above-identified problem in the prior art. Note that the Wildgoose

reference never acknowledges this problem, much less, attempts to solve it. And the Steele reference is entirely unconcerned with this problem.

Examiner's Proposed Combination of Wildgoose and Steele

In an attempt to combine Wildgoose and Steele in a manner that arrives at the invention of claim 1, the following was stated in the 9/18/03 Office Action (see page 3, last seven lines, and page 4, first four lines):

It is noted that Wildgoose et al did not teach of a guide wherein the first guide defines at least a first bore and a second bore therethrough, each of the first and second bores having a center point arranged to be offset from the center point of the plate opening of the tray trial when the first guide is secured to the tray trial; as claimed by applicant. However, in a similar art, Steele et al evidences the use of a trial guide (FIG. 4) with first and second bores offset from the center to create overlapping cuts in the selected areas.

Therefore, given the teaching of Steele et al, it would have been obvious ... to incorporate the overlapping bore of Steele et al in the device to Wildgoose et al to create overlapping cuts in the selected tibia plateau.

There Exists No Legitimate Teaching, Suggestion, or Incentive that Supports the Proposed Combination of Wildgoose and Steele

Presumably, in an attempt to identify a teaching, suggestion, or incentive that would support the proposed combination of Wildgoose and Steele, the following was stated in the 9/18/03 Office Action (see page 4, line 1):

given the teaching of Steele et al.

However, Steele is motivated to use its guide body 17 to produce overlapping, oval shaped cuts to remove a diseased condyle on the distal femur (see column 2, lines 51-54; column 3, line 7; and column 1, lines 18-25). In Wildgoose, the trial 50 has a flat bottom (see Fig. 6) that is configured to be

placed directly on a resected tibia having no condyles left intact (see, e.g., Figs. 15-22 and 25 of Applicants' patent application). Thus, one skilled in the art *given the teaching of Steele et al.* would not have been motivated to incorporate the overlapping bores of Steele in the device of Wildgoose to produce overlapping, oval shaped cuts to remove a diseased condyle because when Wildgoose's flat-bottomed trial 50 is placed on a resected tibia there are no diseased condyles on the tibia to be removed.

As a result, a legitimate teaching, suggestion, or incentive has not been identified that would support the proposed combination of Wildgoose and Steele, nor does one appear to exist. Thus, a prima facie case of obviousness under 35 U.S.C. § 103 has not been established with respect to the invention defined in claim 1.

Discussion Re: Patentability of Claims 2-10

Each of claims 2-10 depends directly or indirectly from claim 1. As a result, each of claims 2-10 is allowable for, at least, the reasons hereinbefore discussed with regard to claim 1.

Discussion Re: Patentability of Claim 11

The discussion regarding the patentability of claim 1 is relevant to the patentability of claim 11. As a result, claim 11 is allowable over the cited art.

Discussion Re: Patentability of Claims 12-18

Each of claims 12-18 depends directly or indirectly from claim 11. As a result, each of claims 12-18 is allowable for, at least, the reasons hereinbefore discussed with regard to claim 11.

Discussion Re: Patentability of Claim 19

The discussion regarding the patentability of claim 1 is relevant to the patentability of claim 19. As a result, claim 19 is allowable over the cited art.

Discussion Re: Patentability of Claim 20

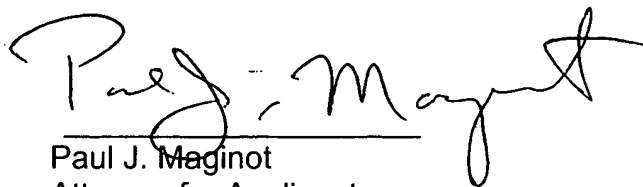
Claim 20 depends directly from claim 19. As a result, claim 20 is allowable for, at least, the reasons hereinbefore discussed with regard to claim 19.

Conclusion

In view of the foregoing amendments and remarks, it is submitted that this application is in condition for allowance. Action to that end is hereby solicited.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Paul J. Maginot", written over a horizontal line.

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